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14 GOOGLE INC.

15 UNITED STATES DISTRICT COURT
16 NORTHERN DISTRICT OF CALIFORNIA
17 SAN FRANCISCO DIVISION

18 ORACLE AMERICA, INC.,

19 Plaintiff,

20 v.

21 GOOGLE INC.,

22 Defendant.

Case No. 3:10-cv-03561 WHA

**MOTION IN LIMINE RE PETER
KESSLER TESTIMONY RE ANDROID
CODE MODIFICATIONS**

Dept.: Courtroom 8, 19th Floor
Judge: Hon. William Alsup

I. INTRODUCTION

Google moves to exclude testimony by Oracle engineer Peter Kessler regarding alleged use of the '104 patent in Android's Dalvik virtual machine source code and modifications that Oracle engineers allegedly made to source code. The issue is whether Mr. Kessler, who was never disclosed by Oracle as a witness who would provide opinion testimony, can provide such expert testimony on behalf of Oracle. He cannot, for at least three reasons. *First*, Oracle disclosed a different engineer, Mr. Vandette, to testify on the topic of Google's alleged use of the '104 patent and the steps he took to turn off the allegedly infringing features in Android. *Second*, the only testimony for which Oracle disclosed Mr. Kessler was *Oracle's*—not Google's—practice of the asserted claims of the patents in suit. *Third*, at deposition, Oracle blocked questioning regarding the very topic for which it now apparently intends to present Mr. Kessler, asserting privilege.

II. ARGUMENT

A. Oracle disclosed Mr. Vandette—not Mr. Kessler—to testify about Google's use of the '104 patent and the steps taken to disable that functionality in the Dalvik source code.

The demonstrative slides disclosed by Oracle to Google in connection with Mr. Kessler's testimony fall into two categories: (1) side-by-side comparisons of Android's Dalvik source code in modified and unmodified form; and (2) slides related to "Use of the '104 Patent in the Dalvik Sources" (as reflected in the titles). This does not square with Oracle's disclosures pursuant to Rule 26(a)(2)(C) of the Federal Rules of Civil Procedure. Those disclosures, dated July 29, 2011, include three Oracle employees designated to offer opinion testimony: Msrs. Landau, Poore, and Vandette. Each is disclosed regarding Dalvik code modifications and benchmark performance testing related to particular patents. The disclosure for Mr. Vandette stated, in relevant part:

Mr. Vandette is a current employee of Oracle who may present testimony on the subject of performance benchmark analysis and testing. Mr. Vandette may testify about the performance benchmark analysis and testing he conducted to measure the benefits Android obtains from practicing United States Patent Nos. RE38,104 ("the '104 patent") and 6,910,205 ("the '205 patent"). Mr. Vandette may also testify about the performance benchmark analysis and testing he conducted to

1 measure the benefits Java SE Embedded obtains from practicing the '205 patent.
 2 *Mr. Vandette may also provide testimony regarding the ways in which Android*
 3 *practices the '104 and '205 patents, and the steps he took to turn off the patented*
 features to measure the performance hits to Android.

4 Oracle America, Inc.'s Disclosures Pursuant to Fed. R. Civ. P. 26(a)(2)(C) (July 29, 2011)
 5 (emphases added). In short, Oracle disclosed Mr. Vandette to testify about Android's alleged use
 6 of the '104 patent and the steps he allegedly took to modify the Android source code for his
 7 benchmark tests. And while Oracle supplemented its Rule 26(a)(2)(C) disclosure on February 7,
 8 2012, that supplemented disclosure only added Mr. Reinhold, not Mr. Kessler.

9 Based on the demonstrative slides, it seems Oracle wants to change horses. The problem
 10 is, Oracle never disclosed Mr. Kessler as an employee expert regarding Android's alleged use of
 11 the '104 patent and the steps he took to modify the Android source code for his benchmark tests.
 12 Because Mr. Kessler was not so disclosed—in contrast to Mr. Vandette, who was explicitly
 13 disclosed—Oracle should be precluded from eliciting from Mr. Kessler testimony regarding
 14 Android's alleged use of the '104 patent and the steps taken to modify the Android source code.

15 **B. Mr. Kessler was only disclosed to testify about *Oracle's* use of the '104 patent.**

16 In addition to Oracle's failure to disclose Mr. Kessler as an employee expert to testify
 17 about Android's use of the '104 patent and the steps taken to modify the Android source code—
 18 and its actual disclosure of someone else on those topics—Oracle's witness list also failed to
 19 disclose Mr. Kessler regarding these topics. According to Oracle's witness list, "Mr. Kessler is
 20 an Oracle engineer. He may testify regarding *Oracle's* products that practice the asserted claims
 21 of the patents-in-suit." (Dkt. No. 525-2 at 8 (emphasis added).) He is not disclosed regarding
 22 *Google's* alleged use of the '104 patent or modifications to Android source code. As such, he
 23 should be precluded from testifying on those issues.

24
 25 **C. Oracle asserted privilege regarding the topics for which it now intends Mr.**
 Kessler to testify.

26 If the lack of proper disclosures are not sufficient grounds to exclude Mr. Kessler's
 27 proposed testimony, the fact that Oracle asserted privilege over the very topics for which Mr.
 28 Kessler is now being offered should be. As reflected in the demonstrative slides, the main topic

1 for which Oracle intends to use Mr. Kessler is “Use of the ’104 Patent in the Dalvik Sources.” In
 2 other words, alleged infringement of the ’104 patent by Android. But when asked whether he did
 3 an infringement analysis for the ’104 patent, Oracle limited the answer to a simple yes or no
 4 question.

5 Q. Have you ever done an infringement analysis on Android products for the
 ’104 patent?

6 Mr. Norton: You may answer that question a yes or no.

A: Yes.

7
 8 *See* Kessler Dep. 71:13-17. Oracle would not even allow questioning as to the timing of this
 9 analysis, instructing the witness not to answer.

10 Q. When did you conduct these infringement analyses?

MR. NORTON: I'll object and instruct the witness not to answer the question on
 11 grounds of attorney-client privilege and work product.

Q. Will you follow that instruction?

12 A. Yes, I will.

13 *Id.* at 73:5-12. Given its refusal to allow discovery into Mr. Kessler's infringement analysis of
 14 the ’104 patent, Oracle cannot now offer Mr. Kessler to testify at trial regarding “Use of the ’104
 15 Patent in the Dalvik Sources.”

16 **III. CONCLUSION**

17 For the foregoing reasons, the Court should grant a motion *in limine* prohibiting Mr.
 18 Kessler from testifying regarding Android's alleged practice of the ’104 patent and the steps
 19 taken to modify the Android source code.

20 Dated: May 6, 2012

KEKER & VAN NEST LLP

21
 22 By: /s/ Robert A. Van Nest
 ROBERT A. VAN NEST

23 Attorneys for Defendant
 24 GOOGLE INC.